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REMARKS

The present communication is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Remarks to the Abstract

In the Office Action, the Examiner objected to the Abstract because "**The abstract of the disclosure is objected to because it contains more than 150 words and is not in a single paragraph, correction is required. See MPEP § 608.01(b).**" Applicant has amended the abstract to comply with MPEP § 608.01(b).

Status of Claims

Claims 1 through 6 are pending in the application. Claims 1 through 6 have been rejected. Claim 3 has been amended.

CLAIM REJECTIONS

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 1 through 6 under 35 U.S.C. § 103(a), as being unpatentable over Bisdikian et al., U.S Patent 5,974,406 and Witek at el., U.S Patent 6,253,188.

Applicant believes the Examiner has misinterpreted the cited reference, resulting in their misapplication to the pending claims. Therefore, it appears that the Examiner has failed to establish a prima facie case of obviousness and applicant must respectfully traverse the rejection of claims 1 through 6. More specifically, Applicant asserts that the above listed combination of separate and unrelated references do not

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form the basis of a proper obviousness type rejection because: (1) that the Examiner hasn't shown any motivation to combine the cited references, and (2) even if it were proper to combine the cited references, the combination of the references does not teach or suggest all the claimed limitations of independent claim 1.

As the Examiner should well know, the basic rule of law with regards to obviousness type rejections is that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

More specifically, independent claims 1 and 4 recite a method for matching buyers and sellers across a network, and independent claim 3 recites a system for matching buyers and sellers across a network. Each of these independent claims recites the limitations of:

1. receiving a buyer request, including a request for a specific product or service,

2. searching sites on a network of (web) sites for sell ads for sellers for items or services matching the buyer request, and

3. notifying either the associated seller (claim1) or the associated buyer (claim 4).

Contrary to the claimed limitations, the two cited references teach:

> ***Bisdikian reference*** - A method and apparatus for providing customized notification in response to a search query. Moreover, with this invention, a query is received from a user via a user interface. The user also selected a time and means of notification, such as for

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example, by fax at a specified time. The system will also receive several notification choices from both the user and a supplier of information and match the choices so that a supplier can notify a user in accordance with a mutually selected time and means of notification. (Abstract)

Witek reference - A system and method for providing classified ads over the Internet. The system includes a plurality of regional newspaper World Wide Web servers, and associated newspaper classified ad generators; a central classified ad information collection and distribution facility, and a central World Wide Web application server facility, all connected to the Internet such that Internet users can connect to the Newspaper Web server and central Web application server facility to search for and obtain classified ads. The Web application server facility includes one of more application servers and one or more newspaper classified ad database servers. The system apparatus features elements which enable Internet users to enter the system at the newspaper Web server and subsequently search for classified ads held in the ad databases at the database servers through the application servers at the central web application facility. Additionally, the system features elements to enable users to search for the newspaper classified ads at the database servers using a client-server method that includes a common gateway interface procedure. Additionally, the system ad generator includes elements for automatically generating ad records for inclusion at the database servers of the central Web application facility which are derived from the newspaper print ad feed. Still further, the system includes elements at the collection and distribution facility for automatically collecting ads produced at the newspaper ad generators and providing them to the database servers on a scheduled bases. The method features steps for supporting the common-gateway-interface searching procedures which can be carried out in multiple stages. Additionally the method features

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steps for automatically generating classified ad record information in substantially numerical form which is pre-sorted to support improved speed in search the ad record databases.

As was admitted by the Examiner, although the Bisdikian reference teaches some of the claimed limitations, it does not teach the combination of these limitations with "a search for matching ads on sites connected to the network." The Examiner asserted that the Witek reference remedies that failure and that it would have been obvious and appropriate to combine these references, thereby resulting in the claimed methods and system. Applicant asserts that the Examiner used impermissible hindsight to reconstruct the Applicant's invention by using the Applicant's structure as a template and selecting elements from the references to fill the gaps (see In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fcd. Cir. 1991). Applicant notes that for the purpose of considering whether a suggested combination may be used to establish implicit teaching, motivation, or suggestion, the references to be combined must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination.

> "[T]he test for establishing an implicit teaching, motivation, or suggestion is what the combination of these two statements of Evans would have suggested to those of ordinary skill in the art, the two statements cannot be viewed in the abstract...Rather, they must be considered in the context of the teaching of the entire reference." *In re Kotzab*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000)

There is no motivation, explicit or implicit, in either of the references that would lead one of ordinary skill in the art to combine its teachings with the other reference. Applicant respectfully asserts that an adequate consideration of the prior art cited by the Examiner as a whole, could not have been used to establish sufficient implicit teaching, motivation, or suggestion of the present invention.

Furthermore, Applicant would like to point out to the Examiner that Witek does not teach the searching of sites for ads, but rather teaches the querying of a single ads database, which single ads database is populated by data aggregated from

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one or more related databases. More specifically, Witek teaches having a network of related classified databases and using the Internet as a transport medium to aggregate the data from multiple database to one main database, which main database is queried when a search is to be performed. One of ordinary skill in the computer arts would know that there is a significant difference between consistently updating a single database table with data from a fixed set of related database tables (as taught in Witek) and dynamically searching any number of unrelated (web) sites (as claimed). Therefore, even if the combination of references was appropriate, this combination of references does not teach or suggest all the limitations of independent claims 1, 3 and 4.

Furthermore, Applicant would like to point out that claims 4 recites searching sites for both buyers and sellers and matching the buyers and sellers without either submitting a request. This set of limitation is neither taught nor suggested in either of the cited references, individually or jointly.

Therefore, Applicant respectfully requests the withdrawal of the rejections and allowance of claims 1, 3 and 4. Applicant believes claims 2 , 5 and 6 allowable by virtue of their dependency on allowable claims.
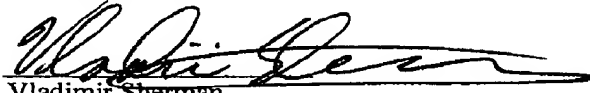
In view of the foregoing amendments and remarks, all pending claims are believed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

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   Please charge any fees associated with this paper to deposit account No. 50-3400.

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